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STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER VAN BRAMER, JOHN W	
			ART UNIT	PAPER NUMBER
			3622	
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			04/02/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/919,844

Applicant(s)

NITTA ET AL.

Examiner

JOHN VAN BRAMER

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6-9, 12-15, 18, 19, 22 and 23 is/are pending in the application.
- 4a) Of the above claim(s) 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-9, 12-15, 18, 19 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Response to Amendment

1. The amendment filed December 29, 2008 cancelled no claims. No claims have been amended and no new Claims have been added. Thus the currently pending claims remain Claims 1-3, 6-9, 12-15, 18, 19, 22, and 23.

Election/Restrictions

2. Applicant's election with traverse of the restriction by original presentation in the reply filed on December 28, 2008 is acknowledged. The traversal is on the ground(s) that Claim 23 is neither distinct nor independent from claims 1, 7, 13, 19, and 22. This is not found persuasive because independent claims 1, 7, 13, 19 and 22 are directed towards an employee communication system that stores employee information, advertising information, and wage information. The system then receives an inquiry from an employee and generates an image containing said information, and simulates purchase information. However, newly submitted claim 23 is directed towards a distinct invention in which employee information is received from a data source company and advertising information is received from an advertisement company. Then providing the employee with advertisements based upon the employee information.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above

and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Additionally, while the applicant has argued that the inventions are not patentably distinct, the applicant has not submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admitted on the record that this is the case. Instead the applicant has argued that they are not patentably distinct and then put forth arguments that the claimed invention is patentably distinct from the prior art references because the claims are directed towards the claim limitations that are found in the original claims but not in restricted claim 23, namely the inclusion of the purchase simulator and the product promotion analyzer.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 6-9, 12-15, 18, 19, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valentino (U.S. Patent Number: 4,648,037) in view of Kramer et al. (U.S. Patent Number: 6,327,574).

Claim 1: Valentino discloses an information inquiry apparatus that receives an information inquiry from a terminal connected through a communication pathway, comprising:

- a. An inquiry information file that stores the inquiry information for each member of an organization (Col 5, lines 12 – 22; and Col 6, lines 49 – 68)
- b. An inquiry image display generator that generates display data from the inquiry information file so that a display image of the display data contains the inquiry information for the member of the organization. (Col 6, line 49 through Col 7, line 21)

- c. An inquiry information transmitter that receives the information inquiry from the terminal and transmits the inquiry image. (Col 6, line 49 through Col 7, line 21)
- d. A purchase simulator that simulates the member's purchase of the advertising company's product using a simulation database containing products and product prices of the advertising company. (Col 14, line 45 through Col 15, line 23)

The Valentino reference discloses that the information requested by the employee includes such information related to possible choices in their retirement plans, health insurance plans, and flexible benefit plans such as cafeteria plans. While these choices are enticements to purchase the displayed products, and therefore qualify as advertisements, Valentino does not specifically state that these are advertisements in which data is collected regarding the success of the promotion and said data is forwarded to the advertisers in a privacy protected manner. However, the analogous art of Kramer (U.S. Patent Number: 6,327,574), discloses that any structured document may be illuminated with advertisements (Col 7, lines 45-53; Figs 3A and 3B). An illumination is a piece of targeted content (Col 4, lines 64-67) whereby sections of documents annotated or replaced with targeted content that expands upon the information in the original content and provides a more interesting presentation of the information (Col 6, lines 23-46) including hyperlinks and promotions (Col 7, lines 8-28). The illumination process described by Kramer processes all personal data

on the client side (the terminal used by the user) to maintain privacy (Col 11, line 55 –67) and data regarding the success of the promotion such as the number of views is sent to the advertisers server (Col 13, lines 26-53). Therefore, it would have been obvious to one of ordinary skill in the art to use the targeted advertising disclosed by Kramer with the apparatus for benefit and financial communication disclosed by Valentino. One would have been motivated to include such advertising in order to provide an advertisement revenue stream that helps to offset the expense of operating the system disclosed by Valentino.

Claim 2: Valentino and Kramer disclose the information inquiry apparatus in claim 1, further comprising: a confirmation information file that stores confirmation information when the employee submits the information inquiry from the terminal and receives the display image. (Valentino: Col 5, lines 49 – 64 and Col 14, lines 34 – 44)

Claim 3: Valentino and Kramer disclose the information inquiry apparatus in claim 2, wherein the confirmation information is sent to the organization. (Valentino: Col 5, lines 49 – 64 and Col 14, lines 34 – 44)

Claim 6: Valentino and Kramer disclose the information inquiry apparatus in claim 1, wherein the advertising information includes information tailored to at least one of an

employee income level, an employee organizational unit and an employee information input. (Valentino: Col 14, lines 45 – 65)

Claim 7: Valentino discloses an employee information communication method, comprising:

- a. Electronically storing employee information including at least one of employee name, employee company, employee number and employee password. (Col 5, lines 12 – 22; and Col 13, lines 52 – 67)
- b. Electronically storing employee detailed wage information including at least one of employee number, employee company, employee name, payment amounts, deduction amounts and date of payment from a second source. (Col 13, lines 52 – 67)
- c. Receiving an inquiry from an employee. (Col 14, lines 19 – 33)
- d. Generating a detailed wage image that includes employee information and employee detailed wage information. (Col 14, lines 19 – 33)
- e. Simulating the employee's purchase of a product using a simulation database containing products and product prices of the advertising company. (Col 14, line 45 through Col 15, line 23)

The Valentino reference discloses that the information requested by the employee includes such information related to possible choices in their retirement plans, health insurance plans, and flexible benefit plans such as cafeteria plans. While these choices are enticements to purchase the displayed

products, and therefore qualify as advertisements, Valentino does not specifically state that these are advertisements in which data is collected regarding the success of the promotion and said data is forwarded to the advertisers in a privacy protected manner. However, the analogous art of Kramer (U.S. Patent Number: 6,327,574), discloses that any structured document may be illuminated with advertisements (Col 7, lines 45-53; Figs 3A and 3B). An illumination is a piece of targeted content (Col 4, lines 64-67) whereby sections of documents annotated or replaced with targeted content that expands upon the information in the original content and provides a more interesting presentation of the information (Col 6, lines 23-46) including hyperlinks and promotions (Col 7, lines 8-28). The illumination process described by Kramer processes all personal data on the client side (the terminal used by the user) to maintain privacy (Col 11, line 55 –67) and data regarding the success of the promotion such as the number of views is sent to the advertisers server (Col 13, lines 26-53). Therefore, it would have been obvious to one of ordinary skill in the art to use the targeted advertising disclosed by Kramer with the apparatus for benefit and financial communication disclosed by Valentino. One would have been motivated to include such advertising in order to provide an advertisement revenue stream that helps to offset the expense of operating the system disclosed by Valentino.

Claim 8: Valentino and Kramer disclose the employee information communication method in claim 7, further comprising electronically storing confirmation information

when the employee submits the inquiry and receives the detailed wage image.

(Valentino: Col 5, lines 49 – 64; and Col 14, lines 34 – 44)

Claim 9: Valentino and Kramer disclose the employee information communication method in claim 8, further comprising sending the confirmation information to the second source. (Valentino: Col 5, lines 49 – 64; and Col 14, lines 34 – 44)

Claim 12: Valentino and Kramer disclose the employee information communication method in claim 7, wherein the advertising information includes information tailored to at least one of an employee income level, an employee organizational unit and an employee information input. (Valentino: Col 14, lines 45 – 65)

Claim 13: Valentino discloses an employee information communication system, comprising:

- a. A first electronic data storage device that stores employee information including at least one of employee name, employee company, employee number and employee password. (Col 4, line 61 through Col 5, line 11; Col 6, line 49 through Col 7, line 21; and Col 13, lines 52 – 67)
- b. A third electronic data storage device that stores employee detailed wage information including at least one of employee number, employee company, employee name, payment amounts, deduction amounts and date of payment

- from a second source. (Col 4, line 61 through Col 5, line 11; Col 6, line 49 through Col 7, line 21; and Col 13, lines 52 – 67)
- c. An image generator that receives an inquiry from an employee and generates a detailed wage image that includes employee information and employee detailed wage information. (Col 4, line 61 through Col 5, line 11; Col 6, line 49 through Col 7, line 21; and Col 13, lines 52 – 67)
- d. A purchase simulator that simulates the employee's purchase of a product using a simulation database containing products and product prices of the advertising company. (Col 14, line 45 through Col 15, line 23)

The Valentino reference discloses that the information requested by the employee includes such information related to possible choices in their retirement plans, health insurance plans, and flexible benefit plans such as cafeteria plans. While these choices are enticements to purchase the displayed products, and therefore qualify as advertisements, Valentino does not specifically state that these are advertisements in which data is collected regarding the success of the promotion and said data is forwarded to the advertisers in a privacy protected manner. However, the analogous art of Kramer (U.S. Patent Number: 6,327,574), discloses that any structured document may be illuminated with advertisements (Col 7, lines 45-53; Figs 3A and 3B). An illumination is a piece of targeted content (Col 4, lines 64-67) whereby sections of documents annotated or replaced with targeted content that expands upon the information in the original content and provides a more interesting presentation of the

information (Col 6, lines 23-46) including hyperlinks and promotions (Col 7, lines 8-28). The illumination process described by Kramer processes all personal data on the client side (the terminal used by the user) to maintain privacy (Col 11, line 55 –67) and data regarding the success of the promotion such as the number of views is sent to the advertisers server (Col 13, lines 26-53). Therefore, it would have been obvious to one of ordinary skill in the art to use the targeted advertising disclosed by Kramer with the apparatus for benefit and financial communication disclosed by Valentino. One would have been motivated to include such advertising in order to provide an advertisement revenue stream that helps to offset the expense of operating the system disclosed by Valentino.

Claim 14: Valentino and Kramer disclose the employee information system in claim 13, further comprising a fourth electronic data storage device that stores confirmation information when the employee submits the inquiry and receives the detailed wage image. (Valentino: Col 5, lines 49 – 64: and Col 14, lines 34 – 44)

Claim 15: Valentino and Kramer disclose the employee information system in claim 14, wherein the confirmation information is sent to the second source. (Valentino: Col 5, lines 49 – 64: and Col 14, lines 34 – 44)

Claim 18: Valentino and Kramer disclose the employee information apparatus in claim 13, wherein the advertising information includes information tailored to at least

one of an employee income level, an employee organizational unit and an employee information input. (Valentino: Col 14, lines 45 – 65)

Claim 19: Valentino discloses a wage information management apparatus, comprising:

- a. A detailed wage data structure that stores details of an employee's wage. (Col 5, line 66 through Col 6, line 10)
- b. A detailed wage inquiry authenticator that authenticates a wage inquiry based on an authentication code in the wage inquiry. (Col 6, lines 11 – 41)
- c. A communicator that, when the detailed wage authenticator authenticates the wage inquiry, sends the detailed wage data to a source of the wage inquiry. (Col 6, line 49 through Col 7, line 21)
- d. A deduction information collector that accepts a deduction information from the source of the wage inquiry. (Col 14, lines 19 – 44)
- e. A deduction information recorder that records the deduction information sent from the source of the wage inquiry. (Col 14, lines 19 – 44)
- f. A confirmation data structure that generates and stores confirmation information, to be sent to a second source, when the source submits the wage inquiry and the communicator sends the detailed wage data. (Col 5, lines 49 – 64 and Col 14, lines 19 – 44)

- g. A simulation database data structure containing products and product prices of an advertising company used for product purchase simulation. (Col 14, line 45 through Col 15, line 23)

The Valentino reference discloses the generation of storage of confirmation information, he does not specifically state that the confirmation is sent to and advertiser. However, the analogous teachings of Kramer disclose advertiser's providing illuminations on structured documents. The illumination process described by Kramer processes all personal data on the client side (the terminal used by the user) to maintain privacy (Col 11, line 55 –67) and data regarding the success of the promotion such as the number of views (confirmations) is sent to the advertisers server (Col 13, lines 26-53). Therefore, it would have been obvious to one of ordinary skill in the art to use the targeted advertising disclosed by Kramer with the apparatus for benefit and financial communication disclosed by Valentino. One would have been motivated to include such advertising in order to provide an advertisement revenue stream that helps to offset the expense of operating the system disclosed by Valentino.

Claim 22: Valentino discloses an employee information communication apparatus, comprising:

- a. A first electronic data structure that stores employee information including at least one of employee name, employee company, employee number and

- employee password. (Col 4, line 61 through Col 5, line 11; Col 6, line 49 through Col 7, line 21; and Col 13, lines 52 – 67)
- b. A third electronic data structure that stores employee detailed wage information including at least one of employee number, employee company, employee name, payment amounts, deduction amounts and date of payment from a second source. (Col 4, line 61 through Col 5, line 11; Col 6, line 49 through Col 7, line 21; and Col 13, lines 52 – 67)
- c. An image generator that receives an inquiry from an employee and generates a detailed wage image that includes employee information and employee detailed wage information. (Col 4, line 61 through Col 5, line 11; Col 6, line 49 through Col 7, line 21; and Col 13, lines 52 – 67)
- d. A purchase simulator that simulates the employee's purchase of a product using a simulation database containing products and product prices of the advertising company. (Col 14, line 45 through Col 15, line 23)

The Valentino reference discloses that the information requested by the employee includes such information related to possible choices in their retirement plans, health insurance plans, and flexible benefit plans such as cafeteria plans. While these choices are enticements to purchase the displayed products, and therefore qualify as advertisements, Valentino does not specifically state that these are advertisements in which data is collected regarding the success of the promotion and said data is forwarded to the advertisers in a privacy protected manner. However, the analogous art of Kramer (U.S. Patent

Number: 6,327,574), discloses that any structured document may be illuminated with advertisements (Col 7, lines 45-53; Figs 3A and 3B). An illumination is a piece of targeted content (Col 4, lines 64-67) whereby sections of documents annotated or replaced with targeted content that expands upon the information in the original content and provides a more interesting presentation of the information (Col 6, lines 23-46) including hyperlinks and promotions (Col 7, lines 8-28). The illumination process described by Kramer processes all personal data on the client side (the terminal used by the user) to maintain privacy (Col 11, line 55-67) and data regarding the success of the promotion such as the number of views is sent to the advertisers server (Col 13, lines 26-53). Therefore, it would have been obvious to one of ordinary skill in the art to use the targeted advertising disclosed by Kramer with the apparatus for benefit and financial communication disclosed by Valentino. One would have been motivated to include such advertising in order to provide an advertisement revenue stream that helps to offset the expense of operating the system disclosed by Valentino.

Response to Arguments

5. Applicant's arguments filed December 29, 2008 have been fully considered but they are not persuasive.
 - a. The applicant argues that Kramer still fails to disclose the feature of an information inquiry apparatus...comprising...a product promotion analyzer that computes...and send the product promotion result of more than one member in

aggregate to the advertising company. However, Kramer specifically discloses computing data regarding the success of the promotion such as the number of views and sending this data to the advertisers server (Col 13, lines 26-53).

b. The applicant discloses Kramer describes that the illumination process is processed on the client side and not in a separate apparatus. While the examiner does not agree that the claimed apparatus must be separate from the terminal in the currently pending claims, since it is connected through a communication pathway it might be all connected together as a display, keyboard, and computer processing unit in a single operating unit. However, Kramer discloses in Col 16 lines 32-47 that the secure client database does not have to reside on the client computer but that it may reside on other devices but be logically controlled by the client side computer. Furthermore, Kramer discloses in Col 13, lines 33-53 that the actual promotion analyzing can occur on the server side.

c. The applicant argues that Kramer does not disclose the purchase simulator that simulates the member's purchases. However, as indicated by the previous Office Action, the Valentino reference discloses the purchase simulator in (Col 14, line 45 through Col 15, line 23).

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN VAN BRAMER whose telephone number is (571)272-8198. The examiner can normally be reached on 6am - 4pm Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JV

/J. V./

Examiner, Art Unit 3622